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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,635	03/09/2001	Tadamasa Kitsukawa	50P4371	8537

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EXAMINER

MANNING, JOHN

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/802,635	KITSUKAWA, TADAMASA	
	Examiner	Art Unit	
	John Manning	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/29/05, 12/05/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Appeal Brief

1. In view of the Appeal Brief filed on 28 November 2005, PROSECUTION IS HEREBY REOPENED. New ground of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Because the response to the amendment of 10 August 2005 necessitated new grounds of rejection, this action too is made Final.

Claim Objections

2. Claim 2 is objected to because of the following informalities: there is insufficient antecedent basis for the limitation of "*the* access restriction table" in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not support the recited limitation of “a program for billing entities based at least in part on access Web sites, the program discriminating between public Web sites and private Web sites”.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Connelly (US Pat No 6,144,376) in view of Urakoshi (US Pat No 6,067,564) further in view of Watson (US Pat No 5,289,271).

In regard to claim 1, Connelly discloses "a method and apparatus for merging, displaying and accessing PC content listings via a television user interface. "PC content" in the context of this application include Internet listings, Web sites, local or on-line games and any other PC content available to PC users" (Col 2, Lines 61-66). Connelly discloses a table listing plural virtual channel shown in Figure 4. The claimed step of "enabling the consumer to use a television to access content associated with a virtual channel" is met by Figures 4 and 3B. "FIG. 4 illustrates the method and apparatus of the present invention in further detail. Display 300 is coupled to processing unit 400 and is controlled via remote control 175. As illustrated in FIG. 4, processing unit 400 is capable of making a connection to the Internet, Processing unit 400 may be a computer system such as illustrated in FIG. 2 or any other form of processing unit that can perform the functions required to access a television channel and a PC. Display 300 replaces the television set in the user's living room, and can be utilized for all normal television viewing as well as to access PC content" (Col 5, Lines 13-24; also see: Col 4, Line 34 - Col 5, Line 12). The Connelly reference fails to explicitly disclose "establishing a access restriction table", "selectively restricting access to content using the access flags" and "each access flag indicating whether the channel can be accessed based on user ID". Urakoshi teaches "establishing a access restriction table", "selectively restricting access to content using the access flags" and "each access flag indicating whether the channel can be accessed based on user ID" so as to allow parents to control the content that their child accesses. "On the program purchase screen 60, a personal identification number (personal code) and a password

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corresponding to the personal identification number are inputted (step 53). When the combination thereof matches the one stored, the purchase of the programs is permitted" (Col 5, Lines 9-14; also see: Col 6, Lines 22-44; Col 6, Lines 52-67; Col 8, Lines 15-41). Consequently, it would have been obvious to one of ordinary skill in the art to implement Connelly with "establishing a access restriction table", "selectively restricting access to content using the access flags" and "each access flag indicating whether the channel can be accessed based on user ID" for the stated advantage. The aforementioned combined teaching fails to explicitly disclose recording a portion of the content accessed and a time of access record and billing the customer based on the on the record. Watson teaches recording a portion of the content accessed and a time of access record and billing the customer based on the on the record so as to enable subscribers to be charged a fee based upon their actual usage rather than a flat rate. "The invention is an apparatus for (1) recording the specific channels to which the device is tuned; and (2) the periods of time for which it is tuned to each respective channel; and (3) for periodically reporting the information, in time units allocated to each channel, to the originator of the cable signal; (4) all without participation by the individual cable user; and (5) without the necessity of intrusion into the individual turning circuit" (Col 3, Lines 54-61). Consequently, it would have been obvious to one of ordinary skill in the art to implement the combined teaching with recording a portion of the content accessed and a time of access record and billing the customer based on the on the record for the stated advantage.

In regard to claim 2, the claimed step of "enabling a consumer to use a television to access content provided by at least one web site and at least one television signal source" is met by Figures 4 and 3B (See: Col 5, Lines 13-24; Col 4, Line 34 - Col 5, Line 12). The Connelly reference fails to explicitly disclose an access restriction table. Urakoshi teaches an access restriction table so as to allow parents to control the content that their child accesses (See: Col 5, Lines 9-14; Col 6, Lines 22-44; Col 6, Lines 52-67; Col 8, Lines 15-41). Consequently, it would have been obvious to one of ordinary skill in the art to implement Connelly with an access restriction table for the stated advantage. The aforementioned combined teaching fails to explicitly disclose recording a portion of the content accessed and a time of access record and billing the customer based on the on the record. Watson teaches recording a portion of the content accessed and a time of access record and billing the customer based on the on the record so as to enable subscribers to be charged a fee based upon their actual usage rather than a flat rate. "The invention is an apparatus for (1) recording the specific channels to which the device is tuned; and (2) the periods of time for which it is tuned to each respective channel; and (3) for periodically reporting the information, in time units allocated to each channel, to the originator of the cable signal; (4) all without participation by the individual cable user; and (5) without the necessity of intrusion into the individual turning circuit" (Col 3, Lines 54-61). Consequently, it would have been obvious to one of ordinary skill in the art to implement the combined teaching with recording a portion of the content accessed and a time of access record and billing the customer based on the on the record for the stated advantage.

Claim 3 is met by that discussed above for the method of claim 2.

In regard to claim 5, as discussed for claim 2, Urakoshi discloses restricting access to content using an "access flag" or indicator in order to allow parents to control the content that their child accesses (See: Col 5, Lines 9-14; Col 6, Lines 22-44; Col 6, Lines 52-67; Col 8, Lines 15-41).

In regard to claim 7, Watson discloses storing the user access information in storage element 34. Storage element stores information in an organized fashion, hence storage element 34 meets the limitation of a database.

In regard to claim 8, Watson discloses retrieving the access record from the database. "The information of a positive reception by receiver 26 and the time measured by counter 30 are then transmitted to a storage element 34. The indication of a particular frequency and the time units during which the particular frequency is received by cable usage box 12 is transmitted from storage element 34 to output element 28. Output element 28 provides appropriate formatting for a digital word, which is in turn modulated with an appropriate radio frequency for transmission of the stored information. Control module 32 periodically directs output element 28 to transmit the appropriately formatted information through trunk cable 20 upon request to the origination center 14" (Col 5-6, Lines 61-7). The subscriber is billed based on the access record; therefore the billable content has been determined.

Claim 9 is met by that discussed for the method of claim 2.

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7. Claim 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Connelly in view of Urakoshi further in view of Watson and further in view of Linehan (US Pat Pub No 2004/0249726)

In regard to claims 4, the combined teaching discloses enabling a consumer to use a television to access content provided by an online service and a television signal source with a subscriber interface for maintaining a virtual channel table having entries for a plurality of virtual channel numbers where the access of content is recorded. The combined teaching is silent with respect to billing the owner of the content accessed. Linehan teaches billing the owner of accessed content so as to generate revenue for the cable provider (See Paragraph 0033). Consequently, it would have been obvious to one of ordinary skill in the art to implement the combined teaching with billing the owner of accessed content for the stated advantage.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Connelly in view of Goodwin (US Pat App Pub No 20020091756).

In regard to claim 10, the claimed limitations of "at least one web server", "at least one interactive television system server", "at least one television signal source", "at least one interactive television" and "at least one interactive television, the interactive television receiving information from the Web server, the interactive television system sever, and the television signal source" are met by Figures 4 and 3B (See: Col 5, Lines 13-24; Col 4, Line 34 - Col 5, Line 12). The Connelly reference fails to explicitly disclose a program for billing entities based at least in part on access Web sites, the program discriminating between public Web sites and private Web sites. Goodwin

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teaches a program for billing entities based at least in part on access Web sites, the program discriminating between public Web sites and private Web sites so as to allow a perspective purchaser to determine if they are interested in the service being provided by the site. The free introductory tour or preview of the site is the public Web site.

Upon log-in, the user accessing the private area. "Shown in FIG. 2 there are typically three immediate links directly connected to this network record system (50) invention. First, is a new user link (203). Consequently, someone who wishes to sign-up for the service must necessarily give information that will enable the service to be activated for their use (see FIGS. 2a1, 2a2, 2a3). This would include identifying information, billing information, and the like. Second, will be a tour link (205) which is essentially a free "look" at the network record system service (50). Many web sites that charge a subscription for full use of the site will give a free introductory tour or preview of the site to allow a perspective purchaser to determine if they are interested in the service being provided by the site. Finally, the introductory web page (21) allows one to log into the client database (22) using the log-in link (204) (see FIG. 2b)" (Paragraph 0039).

Consequently, it would have been obvious to one of ordinary skill in the art to implement Connelly with a program for billing entities based at least in part on access Web sites, the program discriminating between public Web sites and private Web sites for the stated advantage.

9. Claims 11-12 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Connelly in view of Goodwin further in view of Watson.

In regard to claims 11-12, the aforementioned combined teaching fails to explicitly disclose recording a portion of the content accessed and a time of access record and billing the customer based on the on the record. Watson teaches recording a portion of the content accessed and a time of access record and billing the customer based on the on the record so as to enable subscribers to be charged a fee based upon their actual usage rather than a flat rate. "The invention is an apparatus for (1) recording the specific channels to which the device is tuned; and (2) the periods of time for which it is tuned to each respective channel; and (3) for periodically reporting the information, in time units allocated to each channel, to the originator of the cable signal; (4) all without participation by the individual cable user; and (5) without the necessity of intrusion into the individual turning circuit" (Col 3, Lines 54-61). Consequently, it would have been obvious to one of ordinary skill in the art to implement the combined teaching with recording a portion of the content accessed and a time of access record and billing the customer based on the on the record for the stated advantage.

In regard to claim 14, as discussed for claims 10, Watson discloses restricting access to content using an "access flag" or indicator in order to allow parents to control the content that their child accesses.

Claim 15 is met by that discussed for the method of claim 10.

In regard to claim 16-18, Watson discloses storing the user access information in storage element 34 and subsequently retrieving the information. Storage element stores information in an organized fashion, hence storage element 34 meets the limitation of a database. "The information of a positive reception by receiver 26 and the

time measured by counter 30 are then transmitted to a storage element 34. The indication of a particular frequency and the time units during which the particular frequency is received by cable usage box 12 is transmitted from storage element 34 to output element 28. Output element 28 provides appropriate formatting for a digital word, which is in turn modulated with an appropriate radio frequency for transmission of the stored information. Control module 32 periodically directs output element 28 to transmit the appropriately formatted information through trunk cable 20 upon request to the origination center 14" (Col 5-6, Lines 61-7). The subscriber is billed based on the access record; therefore the billable content has been determined.

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Connelly in view of Goodwin further in view of Watson and further view of Linehan.

In regard to claim 13, the combined teaching discloses enabling a consumer to use a television to access content provided by an online service and a television signal source with a subscriber interface for maintaining a virtual channel table having entries for a plurality of virtual channel numbers where the access of content is recorded. The combined teaching is silent with respect to billing the owner of the content accessed. Linehan teaches billing the owner of accessed content so as to generate revenue for the cable provider (See Paragraph 0033). Consequently, it would have been obvious to one of ordinary skill in the art to implement the combined teaching with billing the owner of accessed content for the stated advantage.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Manning whose telephone number is 571-272-7352. The examiner can normally be reached on M-F: 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM
March 6, 2006



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